

## **REMARKS**

### **Status of the Claims**

- Claims 1-20 and 25-33 are pending in the Application after entry of this amendment.
- Claims 1-20, and 31-33 are rejected by Examiner.
- Claims 25-30 are withdrawn by Examiner via restriction.

### **Claim Rejections Pursuant to 35 U.S.C. §103**

Claims 1–20, and 31-33 stand rejected under 35 U.S.C. § 103(a) as being unpatentable over U.S. Patent Publication No. 2002/0023140 to Hile et al. (Hile) in view of U.S. Patent Publication No. 2005/0283462 to Pennec et al. (Pennec). Applicant respectfully traverses the rejection.

Hile teaches a Electronic Document Delivery System (Title) having a method “for transferring data files between a first computing device and a second computing device interconnected by a network. The method includes: establishing a first network connection between the first computing device and a second computing device; registering a file transfer request for a given data file with a server application residing on the second computing device; establishing a second network connection between the first computing device and the second computing device, such that the second network connection is independent from the first network connection; retrieving the file transfer request from the server application via the second network connection; and transferring the data file via the second network connection in response to the file transfer request retrieved from the server application.” (See Hile, paragraph 0005)

Hile teaches a direct communication from the user-requesting application to register requests for document deliveries. As stated in paragraph 0014 with reference to Figure 1 of Hile:

“The server subsystem generally includes a server application 22 which is responsible for coordinating the execution of file transfer requests. A requesting application 24 associated with the user subsystem is operable to establish a network connection to the server

application 22 and to register a file transfer request with the server application 22.” (Hile, paragraph 0014)

Applicant also notes that Hile, Figure 3, teaches a file transfer is initiated by a user that wishes to send a file to another computer. In Hile, this is accomplished by having a user fill out a file “Send Form” to an application server (see Figure 3, items 42-56). As stated in paragraph 0018 of Hile:

“To schedule or register a file transfer, the user fills in the Send form 50. In particular, the user enters an email address for the recipient of the file and selects the file or *files they wish to send.*” (Hile, paragraph 0018).

As stated in paragraph 0019 of Hile:

“Next, *the selected file must be transferred from the sender's computing device to the server.*” (Hile, paragraph 0019)

Thus, Applicant notes that Hile teaches using a direct communication between a user-requesting application and a server application to register a file transfer request in paragraph 0014. The transfer requests use “Send Forms” because the direction of the transfer is to “deliver” a file from a user/client to another entity on a network. Applicant notes that Hile does not teach using a “task request generated by a remote client computer, the task request requesting a file from the local computer” as recited in independent Claims, 1, 8, and 15.

Applicant respectfully submits that Hile fails to teach a remote client “requesting” a file. In distinction, Hile teaches a file transfer from a sender’s computing device to the server. (see Hile, paragraphs 0018-0019 and Figure 3). The present claims recite requesting a file whereas Hile teaches sending a file.

Page 3 of the present Office Action dated 5/2/07 states:

“Although Hile disclosed the invention substantially as claimed, Hile is silence regarding disclosed the task request generated by a remote client computer, the task request requesting a file from the local computer.” (Office Action, Page 3)

Applicant agrees that Hile does not disclose the element in independent Claim 1 that includes “the task request generated by a remote client computer, the task requesting a file

from the local computer.” However, Applicant respectfully disagrees that a combination of Hile and Pennec resolves the deficiency in the Hile teaching because the combination of references is inoperable. Specifically, the addition of the teachings of Pennec to the teachings of Hile impermissibly changes the principle of operation of Hile as expressed in MPEP §2143.01 Part VI.

MPEP §2143.01 Part VI states:

**THE PROPOSED MODIFICATION CANNOT CHANGE THE PRINCIPLE OF  
OPERATION OF A REFERENCE**

“If the proposed modification or combination of the prior art would change the principle of operation of the prior art invention being modified, then the teachings of the references are not sufficient to render the claims *prima facie* obvious.”

(MPEP §2143.01, Part VI)

Pennec discloses a method and system which comprises receiving a request for the file, where the request comprises data identifying the remote server, checking that the file is locally stored, forwarding the file to the remote server when the file has been locally modified, and deleting the information according to which said file is locally stored. (See Pennec, Abstract)

Figure 1 of Pennec depicts a Client 10 connected to a local LAN 12 which is also connected to the Local File Server 11. The LAN 11 is connected via a Router 14 to a WAN 15 to a Home File Server 15. One function offered by Pennec is the transfer of a requested file to a client. However, Pennec places a restriction in operation of the system and method. In Pennec paragraph 0036, Pennec teaches that configuration does not allow direct file transfers between the Client and the Home File Server. Pennec teaches:

“There is no direct exchange between the client 400 and the home server 402.”

(Pennec, paragraph 0036).

Thus, if the desired file resides on the WAN-based Home file Server 15, then a transfer is made between the Home File Server and the Local File Server across the WAN. The desired file can then be transferred from the Local File Server to the Client. Pennec describes this in paragraph 0043:

“If the file is not in the local server ("no" answer), the local server requests the file to the home server 53, stores this file in its memory and its identification in the guest client table, and then forwards the file to the client.” (Pennec, Paragraph 0043).

Since Pennec does not allow direct client to server file transfers, and Hile relies on a direct communication between the user and the server to register requests to deliver files from a user to some destination (See Hile, paragraph 0014), then the addition of Pennec to Hile impermissibly changes the principle of operation of Hile because Pennec forces the Hile to avoid direct user to server transactions in registering requests for files. Since the addition of Pennec to Hile changes the principle of operation of Hile, then, according to MPEP §2143.01 Part VI, the teachings of the references are “not sufficient to render the claims of the present application prima facie obvious”. Thus, there is no motivation to combine Hile and Pennec.

In another aspect of the combination of Hile and Pennec, if Hile were modified per Pennec, then direct user to server requests for file deliveries would be disallowed because Pennec does not allow direct client to home server transactions. With this modification, Hile would never receive file delivery requests. The result is that Hile is rendered inoperable because Hile relies on direct client (user) to server communications to register a file delivery request. Since Pennec modifies Hile to prohibit direct client to server communications, then Hile is rendered inoperative when combined with Pennec.

In summary, Hile fails to teach the Claim 1 element of a “task request generated by a remote client computer, the task request requesting a file from the local computer” because Hile fails to teach a remote client “requesting” a file because Hile only teaches “delivering” a file. Whereas the present claims recite requesting a file, Hile teaches sending a file. Pennec teaches a file transfer from a home file server to a client that must go through the local file server because there are no direct client to host file server communications. Hile relies on direct client (user) to server transactions. Since the addition of Pennec prohibits direct client to server transactions, the combination of Hile and Pennec is inoperative and impermissibly changes the principle of operation of Hile according to MPEP §2143.01 Part VI. Thus the combination of Hile and Pennec, if combined is “not sufficient to render the claims prima facie obvious”. (See MPEP §2143.01 Part VI).

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**PATENT  
REPLY FILED UNDER EXPEDITED  
PROCEDURE PURSUANT TO  
37 CFR § 1.116**

**Conclusion**

Applicant respectfully submits that the pending claims patentably define over the cited art and respectfully requests reconsideration of all pending claims.

Respectfully submitted,

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